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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,365	08/14/2003	Michael S. H. Chu	7062104001	1647
23517	7590	11/04/2010	EXAMINER	
BINGHAM MCCUTCHEN LLP			RYCKMAN, MELISSA K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/642,365	<b>Applicant(s)</b> CHU ET AL.
	<b>Examiner</b> MELISSA RYCKMAN	<b>Art Unit</b> 3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 8/9/10.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 and 11-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12 and 14-43 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9, 11, 13 and 44-52 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to arguments filed 8/9/10.

#### ***Priority***

As previously stated, the claims are given priority to 8/14/02, as the earlier dates of the CIP applications do not include the first and second legs as stated in the claims.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9, 11-13, 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giesy et al. (U.S. Patent No. 5,152,749) and further in view of Skiba et al. (U.S. Patent No. 6,723,107)

Giesy teaches an implant placement device comprising the following:

- a connector pair (44, 46) for attaching a medical implant (40) to a delivery device (10)
- the connector pair comprising, a closed loop connector (44) located at an end of a medical implant (40)
- a slotted connector (46) formed in a distal end (20b) of a shaft (20) of a delivery device (10)

- for interfitting with the closed loop connector of the medical implant (fig. 3)
- the distal end of the shaft includes a tapered section (Fig. 4) that is substantially straight and conical
- the tapered section of the shaft is substantially straight (Fig. 3, shows straight distal end)
- the distal tip is blunt (Fig. 3)

Giesen fails to disclose wherein the slotted connector includes first and second legs the first leg extending radially into the shaft and the second leg extending axially in a distal direction from the first leg along the shaft and being longer than the first leg and includes a narrowing for locking the looped connector into the second leg. Skiba teaches a device for holding a suture material comprising a slotted connector, wherein the slotted connector includes first and second legs, the first leg extending radially into the shaft and the second leg extending axially in a distal direction from the first leg along the shaft and being longer than the first leg and includes a narrowing in order to permit easy insertion of the suture into the opening and to wedge the suture into tight frictional engagement with the device (Fig. 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Giesen with a slotted connector as taught by Skiba in order to permit easy insertion of the suture into the opening and to wedge the suture into tight frictional engagement with the device.

The combination of Giesen and Skiba further teaches the following limitations

- wherein the second leg is longer than the first leg (Skiba, Fig. 20)

- the second leg extends distally at a 90 degree angle to the first leg (Skiba, Fig. 20)
- the narrowing is formed where the second leg initially extends from the first leg (Skiba, Fig. 20)
- the width of the narrowing is less than that of the loop material (Geisy)
- The second leg of the slotted connector extends axially into the tapered section of the shaft (Skiba, Fig. 20)
- The first leg of the slotted connector is proximal of the tapered section of the shaft (Skiba, Fig. 20)
- The distal tip is solid (Skiba, Fig. 20)
- the first and second legs join at an inside corner and an outside corner (Skiba, Fig. 20), the outside corner being located proximal to the inside corner along the shaft

The embodiment of Skiba as shown in Fig. 20 shows the first and second legs formed at a 90 degree angle, but does not show the outside corner is curved and the inside corner is not curved, however the embodiment of Skiba as shown in Fig. 17 shows curved corners. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the embodiments of Skiba to have one corner curved and the other not curved as this aids in placement of the loop and in using the device

The examiner's position is the rounded portion of the second leg does indeed act as a locking element, the examiner directs the applicant to col. 4, lines 19, 31 and 32

where Skiba states the embodiments as shown in Fig. 14 and Fig. 16 both trap and wedge the suture. The examiner argues that the legs in Fig. 20 would also lock the suture, as the legs in Fig. 20 are very similar to the legs in Fig. 16 where Skiba does state the suture is locked.

#### ***Response to Arguments***

Applicant's arguments filed 8/9/10 have been fully considered. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Skiba teaches the curves help to trap the suture (col. 4, ll. 38-42), therefore adding one of the curves to the embodiment as shown in Fig. 20 would help to trap the suture, which in turn aids in placement of the loop and using the device.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on a flexible schedule, email address is melissa.ryckman@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR  
/Melissa Ryckman/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773